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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,282	01/22/2002	Mark A. Felkey	WMA01001	7571
25537	7590	07/15/2005	EXAMINER	
MCI, INC 1133 19TH STREET NW WASHINGTON, DC 20036			THEIN, MARIA TERESA T	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,282

Applicant(s)

FELKEY ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 37-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4-1-02; 01-21-03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 37-39 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 22, 2005.

Applicants are respectfully requested to cancel the non-elected claims in response to the Office Action.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on April 1, 2002 and January 21, 2003 are being considered by the examiner.

Drawings

The drawings filed on January 22, 2002 are acceptable.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10, 12-16, 18-19, 21-22, and 24-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process,

machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.

In Toma, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in State Street Bank & Trust Co. v. Signature Financial Group, Inc. never addressed this prong of the test. In State Street Bank & Trust Co., the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See State Street Bank & Trust Co. at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See State Street Bank & Trust Co. at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, State Street abolished the Freeman-Walter-Abele test used in Toma. However, State Street never addressed the second part of the

analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, claims 1-10, 12-16, 18-19, 21-22, and 24-25 have no connection to the technological arts. The preamble and the steps have no connection to a computer or technology. For example claim 1, the steps of receiving, generating and transmitting are broadly interpreted as manual steps. Therefore, the claims are directed towards non-statutory subject matter, i.e. not within technological arts. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such as using a digital computing device and amend the preamble of the claims.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 7-26, and 35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,853,714 to Liljestrand et al.

Regarding claims 1, 11 and 35, Liljestrand discloses a method, apparatus and computer-readable media storing computer-executable instructions for procuring

telecommunications offering remotely comprising: receiving a procurement inquiry, specifying a selected telecommunications offering among voice, Internet and mobile telecommunications offerings (col. 3, lines 54-59; col. 4, lines 46-61); generating procurement data in response to the procurement inquiry and pertaining to the selected telecommunication offering; and transmitting the procurement data (abstract; col. 2, lines 42-51); transmitting the procurement data (abstract; col. 2, lines 42-51).

Regarding claims 2-4, 7, 8-10, Liljestrand discloses the procurement data of pre-sale, ordering and post-sale data (col. 3, lines 54-59); transmitting the pre-sale data comprising value added content which includes at least one of data for matching the selected telecommunication offering with needs of a customer, data for qualifying a customer for the selected telecommunication offering, data for an on-line demonstration of a process for procuring the selected telecommunication offering, data for answers to technical questions, and data for accessing a live network consulting via one of online chat and instant messaging (col. 3, lines 54-59; col. 4, lines 13-29; col. 7, lines 6-53); transmitting post-sale data comprising value added content, the value added content including at least one of data for providing access to exiting orders, data for providing electronic billing, data for sending of a page, data for scheduling of a conference call, data for on-line directory assistance, and tailored data for on one of a telecommunication ordered and a related telecommunication offerings (col. 8, lines 31-47; col. 14, lines 27-44); configuring the voice telecommunication offerings to include calling package, a long distance, a toll free, a conferencing and a calling card telecommunication offering (col. 4, line 46 – col. 5, line 23); configuring the Internet

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telecommunication offerings (col. 4, line 46 – col. 5, line 23); configuring the mobile telecommunication offerings (col. 4, line 46 – col. 5, line 23); graphical user interface (Figure 5).

Regarding claims 12, 17, and 36, Liljestrand discloses a method, apparatus and a computer-readable media storing computer-executable instructions for servicing telecommunication offerings remotely comprising: receiving a service inquiry, the service inquiry specifying search criteria with respect to an order for a telecommunication offering, a customer agent assigned for servicing telecommunication offering order, and a move, change or disconnect of telecommunication offering order (col. 2, lines 42-51; col. 4, lines 34-36; col. 16, lines 50-64); generating service data in response to the service inquiry and pertaining to the search criteria (abstract; col. 2, lines 42-51); and transmitting the service data (abstract; col. 2, lines 42-51).

Regarding claims 13-16, Liljestrand discloses transmitting the service data including at least one of pre-sale, ordering, and post-sale data (col. 3, lines 54-59); transmitting one of the pre-sale, ordering and post-sale data including at least one of online chat, and instant messaging data (col. 3, lines 54-59; col. 3, lines 54-59; col. 4, lines 13-29; col. 7, lines 6-53); post sale data (col. 8, lines 31-47; col. 14, lines 27-44); graphical user interface (Figure 5).

Regarding claims 18-20, Liljestrand discloses a method and a computer-readable media for procuring and servicing telecommunications offerings, comprising: receiving a procurement inquiry and a service inquiry, the procurement inquiry specifying a selected telecommunication offering from among voice, Internet and mobile telecommunications

offering, the service inquiry specifying search criteria with respect to an order for a telecommunication offering, a customer agent assigned for servicing telecommunication offering order, and a move, change or disconnect of telecommunication offering order (col. 2, lines 42-51; col. 3, lines 54-59; col. 4, lines 46-61; col. 4, lines 34-36; col. 16, lines 50-64); generating procurement data and service data (abstract; col. 2, lines 42-51); transmitting the procurement and service data (abstract; col. 2, lines 42-51).

Furthermore, Liljestrand discloses a graphical user interface (Figure 5).

Regarding claims 21-23, Liljestrand discloses a method and computer-readable media storing computer-executable instructions for procuring telecommunications offering remotely comprising: submitting a procurement inquiry, specifying a selected telecommunications offering among voice, Internet and mobile telecommunications offerings (col. 3, lines 54-59; col. 4, lines 46-61); receiving procurement data (abstract; col. 2, lines 42-51); wherein the procurement data is generated in response to the procurement inquiry and pertains to the selected telecommunication offering (abstract; col. 2, lines 42-51). Furthermore, Liljestrand discloses a graphical user interface (Figure 5).

Regarding claims 24-26, Liljestrand discloses a method and a computer-readable media storing computer-executable instructions for servicing telecommunication offerings remotely comprising: submitting a service inquiry, the service inquiry specifying search criteria with respect to an order for a telecommunication offering, a customer agent assigned for servicing telecommunication offering order, and a move, change or disconnect of telecommunication offering order (col. 2, lines 42-51; col. 4,

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lines 34-36; col. 16, lines 50-64); receiving service data (abstract; col. 2, lines 42-51); and wherein the service data is generated in response to the service inquiry and pertains to the search criteria (abstract; col. 2, lines 42-51).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,853,714 to Liljestrand in view of U.S. Patent No. 6,463,420 to Guidice et al. Liljestrand substantially discloses the claimed invention, however, it does not disclose a shopping cart data, order entry data, ordering tracking data, and order status data. Liljestrand discloses an apparatus and method for providing a plurality of transparent enhanced telecommunication services to subscribers (col. 2, lines 38-40). Liljestrand discloses a variety of revenue generating enhanced services (col. 3, lines 54-56).

Guidice, on the other hand, teaches shopping cart data, order entry data, ordering tracking data, and order status data (Figure 2; Figure 4; Figure 5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Liljestrand to include shopping cart data, order entry data, ordering tracking data, and order status data, as taught by

Guidice, in order to increase the efficiency and convenience of tracking the delivery status of orders (Guidice, col. 2, lines 26-27).

Claims 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,853,714 to Liljestrand in view of U.S. Patent No. 6,098,108 to Sridhar et al. Liljestrand substantially discloses the claimed invention, however, it does not disclose a customer browser loaded on a customer client computer; a back office browser loaded on a back office client computer; the server program communicate according to a communication protocol architecture that includes a web layer and application layer; a database layer; a site intelligence server; and the development, staging and production system. Sridhar, on the other hand, teaches a customer browser loaded on a customer client computer; a back office browser loaded on a back office client computer; the server program communicate according to a communication protocol architecture that includes a web layer and application layer; a database layer; a site intelligence server; and the development, staging and production system (Figure 6; Figure 9; Figure 15; Figure 22; col. 5, lines 7-25; col. 9, lines 44-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Liljestrand, to include a customer browser loaded on a customer client computer; a back office browser loaded on a back office client computer; the server program communicate according to a communication protocol architecture that includes a web layer and application layer; a database layer; a site intelligence server; and the development, staging and production

system, as taught by Sridhar, in order to provide enhanced communication between client and server computers coupled through the Internet (Sridhar, col. 1, lines 13-15).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,041,104 to Lipton et al. discloses a method and system for ordering a telecommunication service.

U.S. Patent No. 6,104,999 to Giles et al. discloses a system and method for electronically ordering telecommunication services.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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July 11, 2005

James S. McClellan
JAMES MCCLELLAN
PRIMARY EXAMINER